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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,521	09/10/1999	NAOYUKI MATSUMOTO	35.G0708C/D2	4346

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 05/20/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,521

Applicant(s)

MATSUMOTO, NAOYUKI

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 25-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 25-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

6) Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 2/14/03, and has been entered and made of record. Currently, **claims 25-31** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 29-31**, filed 2/14/03, have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments with respect to **claims 25-28**, filed 2/14/03, have been fully considered but they are not persuasive.
4. Upon review of the current amended **claim 25**, and the prior art of record, the examiner notes that the claim, as amended, can now be interpreted as being anticipated by Kita *et al.* (U.S. Patent Number 5,021,892) alone, which was cited in the previous Office action's rejection of claim 25, along with the reference of Shimotono (U.S. Patent Number 4,964,154). The applicant argues on pages 6 and 7 that Kita and Shimotono fail to teach of checking the operating conditions of the data communication apparatus upon receipt of the commands from the host computer, and a process that allows the commands from the host computer to take precedence over commands from other sources when the data communication apparatus is set in the on-line mode. The examiner finds that Kita can be interpreted as teaching both of these features. Specifically, Kita teaches of a communication step of communicating commands from the host computer to the data communication apparatus through a network (yes in S10 in Fig. 6, and yes

in S200 in Fig. 9, column 7, lines 30 through 44), a checking step of checking, upon the receipt of the commands by the data communication apparatus from the host computer, operating conditions of the data communication apparatus (S201 in Fig. 9, column 7, lines 30 through 44), and a notification step of notifying the host computer of the operating conditions in accordance with the command from the host computer (S202, column 7, lines 30 through 34, and column 15, line 62 through column 16, line 6). Further, Kita teaches that when the data communication apparatus is set in the on-line mode in the setting step (S213), the commands from the host computer take precedence over commands from other sources (see operations (2) in Figs. 6, and 9-10d). Because of this, Kita can now be interpreted as anticipating amended claim 25, with a full discussion appearing below.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. **Claims 25-28** are rejected under 35 U.S.C. 102(e) as being anticipated by Kita *et al.* (U.S. Patent Number 5,021,892, cited in the Office action dated 11/18/02).

Regarding *claim 25*, Kita discloses a method of controlling a data communication apparatus in a data processing system that includes the data communication apparatus and a host computer connected to the data communication apparatus by an interface, with the method comprising a communication step of communicating commands from the host computer to the data communication apparatus through a network (yes in S10 in Fig. 6, and yes in S200 in Fig. 9, column 7, lines 30 through 44), a checking step of checking, upon the receipt of the commands by the data communication apparatus from the host computer, operating conditions of the data communication apparatus (S201 in Fig. 9, column 7, lines 30 through 44), a notification step of notifying the host computer of the operating conditions in accordance with the command from the host computer (S202, column 7, lines 30 through 44, column 15, line 62 through column 16, line 6), and a setting step of setting in the data communication apparatus one of an on-line mode (S213 of Fig. 9, on-line flag set to on), to be operated based on a command from the host computer (see Fig. 9), and an off-line mode (S6 of Fig. 6, on-line flag set to off), to be operated even without a command from the host computer (step S9, operations (1), seen in Figs. 6-8e), wherein when the data communication apparatus is set in the on-line mode in the setting step (S213), the commands from the host computer take precedence over commands from other sources (see operations (2) in Figs. 6, and 9-10d).

Regarding **claim 26**, Kita discloses the method discussed above in claim 25, and further teaches that the notification step notifies the host computer of operating conditions comprising a change in status or internal state of the data communication apparatus (S201 and S202 in Fig. 9, column 15, line 62 through column 16, line 6).

Regarding **claim 27**, Kita discloses the method discussed above in claim 25, and further teaches that the notification step notifies the host computer of the operating conditions in accordance with a command from the host computer (S10 in Fig. 6, and S200-S202 in Fig. 9, column 15, line 62 through column 16, line 6).

Regarding **claim 28**, Kita discloses the method discussed above in claim 25, and further teaches that the data communication apparatus is included in a facsimile apparatus (multifunctional device 1, seen in Fig. 1, with a facsimile control unit 4, column 3, lines 28 through 53).

7. **Claims 29-31** are rejected under 35 U.S.C. 102(b) as being anticipated by Ejiri *et al.* (U.S. Patent Number 4,965,676).

Regarding **claim 29**, Ejiri discloses a method of controlling a data processing apparatus (fax 12) in a data processing system (see Fig. 1) that includes the data processing apparatus (fax 12) and a host computer (PC 50, see Fig. 1, column 2, line 60 through column 3, line 42), the data processing apparatus and the host computer being connected to each other through an interface (RS232C 22), and the data processing apparatus being able to communicate with another device through a network without using the interface (CCA 20, column 3, lines 8 through 36), with the method comprising a command reception step of receiving by the data

processing apparatus, a command from the host computer through the interface (column 3, lines 51 through 66, and column 4, line 57 through column 5, line 60), a determination step of determining the type of command received in the command reception step (column 6, lines 4 through 64), and a notification step of notifying the host computer of information in accordance with the command received in the command reception step through the interface (column 3, lines 51 through 66, and column 4, line 57 through column 5, line 60), wherein the information comprises model type, model version of the data processing apparatus, and cause of a network abnormality (see Figs. 4, 14, and 18).

Regarding **claim 30**, Ejiri discloses the method discussed above in claim 29, and further teaches that the notification step notifies the host computer of the model type and the model version in one set (see Figs. 4, 7, 14, and 18, fax series no., and fax model no.).

Regarding **claim 31**, Ejiri discloses the method discussed above in claim 29, and further teaches that the data processing apparatus is included in a facsimile apparatus (fax 12, seen in Fig. 1, column 2, line 60 through column 3, line 49).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa

Examiner

Art Unit 2622



EDWARD COLES
SUPERVISORY PATENT EXAMINER
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jrp
May 15, 2003